

## **REMARKS**

### **CLAIM STATUS**

Claims 1-27 are pending in this application. Claims 14 -23 have been withdrawn from consideration. It is again noted that claim 24 is an elected claim and that the outstanding Office Action is incomplete as pending claim 24 has not been properly treated.

### **SUMMARY OF OFFICE ACTION**

The outstanding Office Action is a final Action that objects to the drawings, that improperly notes that claim 24 has been rejected (see item 6 of the Office Action Summary (PTOL-326)), that presents a rejection of claims 1-3, 5, 6, 8-11, 13, 25, 26, and 27 under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,251,425 to Kern (hereinafter “Kern”), and that presents a further rejection of claims 4, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kern.

### **FAILURE TO CONSIDER CLAIM 24**

As noted above, the present outstanding Action has failed to treat claim 24 in terms of specifying the reasons for the apparent rejection of this claim set forth by item 6 on the Office Action Summary (PTOL-326). As noted in the last response, MPEP §707.07(d) requires that:

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection.

Not only does the outstanding Action once again violate MPEP §707.07(d), it also again violates Section 706.02(j) of the MPEP that notes that “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” This is more than mere guidance by the MPEP as 35 U.S.C. § 132 requires that the applicant be

notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly, setting forth all relied on rationales to support all rejections in an Office Action in a way that gives the applicant a fair opportunity to respond is mandated by the statute and not something that is left to the Examiner's discretion.

Accordingly as the mere mention that claim 24 is rejected in item 6) on the Office Action Summary (PTOL-326) violates 35 U.S.C. § 132, MPEP § 706.02(j), and MPEP § 707.07(d), the provision of a complete Office Action that properly considers claim 24 is respectfully noted to be in order before any further Office Action can be made final.

### **SUBSTANCE OF THE INTERVIEW**

Applicant acknowledges with appreciation the personal interview granted by Examiner Tawfik to applicant's representative on April 21, 2010. During this interview, Applicant's representative presented arguments treated in detail below as to why the objection to the drawing should be withdrawn and why the present claims (independent claim 1 in particular and claims 2-13 and 24-27 that all depend directly or indirectly from independent claim 1 by reason of their dependency) all clearly patentably define over the teachings and fair suggestions of Kern.

### **OBJECTION TO DRAWINGS**

During the above-noted interview on April 21, 2010, applicant's representative pointed out that the main surface at issue that was added to the recitals by independent claim 1 was clearly disclosed to be part of already illustrated pocket 11 with regard to page 17 of the specification. The Examiner agreed that page 17 of the specification did provide support for the claim 1 recital of a "holding device having a main surface for supporting the envelope during insertion of the sheets into the envelope" based on the teachings at page 17 of the specification as to the disclosed holding device ("pocket 11) having such a main surface. The fact that the present drawings further clearly show how this disclosed main surface of already illustrated pocket 11 will support "the envelope during insertion of the sheets into the envelope," applicant's representative requested withdrawal of this objection.

As the Examiner Agreed that the present drawings clearly show how this disclosed main surface of already illustrated pocket 11 will support “the envelope during insertion of the sheets into the envelope,” the Examiner agreed to withdraw this objection upon the filing of a response pointing out the above points as to the illustration of pocket 11 and the disclosure of it including the Main surface” that will support “the envelope during insertion of the sheets into the envelope.”

Accordingly, withdrawal of this drawing objection is respectfully requested.

**REJECTION UNDER 35 U.S.C. § 102**

The outstanding Action rejection of claims 1-3, 5, 6, 8-11, 13, 25, and 26 under 35 U.S.C. § 102(b) as being allegedly anticipated by Kern was also discussed at the above-noted personal interview granted by Examiner Tawfik to applicant’s representative on April 21, 2010.

In this respect, applicant’s representative noted that Kern was being misinterpreted as to the claim 1 recital of “the main surface of the holding device has a fixed orientation relative to the feed device and to the removal device and maintains the same fixed orientation during feeding and removing of the envelope respectively in the feed and removal directions, the feed device and the removal device being arranged relative to the main surface of the holding device to define a first angle between the feed direction and the main surface of the holding device and a second angle between the removal direction and the main surface of the holding device, the first and second angles being different from each other.” Kern was further noted to being misinterpreted as to the further recital that device having a main surface for supporting the envelope did this “during insertion of the sheets into the envelope.”

With particular regard to this last point and the reliance on all of elements 13-15 as together comprising the claim 1 “holding device,” applicant’s representative pointed out that elements 14 and 15 of Kern were only disclosed to be used to insure envelope conveyance along plate 16 to the pocket 13 at col. 2, lines 21-23. Applicant’s representative further noted that Kern disclosed (at col. 2, lines 40-43) that the envelope holding trap 13 would pivot downward after envelope loading and that this made it clear

that elements 14 and 15 had nothing to do with a surface that would support the envelope “during insertion of the sheets into the envelope” because the envelope in pivoted trap 13 are not associated with 14 and 15 and the envelope in 13 provides the only envelope support in the pivoted position of trap 13. Applicant’s representative further pointed to the showings of Figs. 5 and 6 and in particular noted that Fig. 6 clearly showed that the envelope in the trap 13 at the contents loading position was in no way supported by elements 14 and 15.

It was further noted that prior Actions have only alleged that the package trap 13 was interpreted to correspond to the claim 1 “holding device.” Thus, it was noted that the present outstanding Action that has expanded the interpretation of the claim 1 “holding device” to include the devices 14 and 15 that only cooperate with 16 to feed the envelope into trap 13, and not to support the envelope “during insertion of the sheets into the envelope,” was clearly not reasonable.

The Examiner expressed concern that the requirement that the holding device has a fixed orientation relative to the feed device and relative to the removal device “and maintains the same fixed orientation during feeding and removing of the envelope respectively in the feed and removal directions” should have some advantage. Applicant’s representative noted that as the pocket or holding device of the present invention of independent claim 1 was not moved for envelope insertion and then moved again for packing and removing the packed envelope as in Kern, there were inherently fewer moving parts and less complexity in the claimed device as compared to Kern. It was also noted that maintaining the orientation as claimed had the advantage over Kern of avoiding alignment problems due to moving the pocket envelope holding device as in Kern. The Examiner is invited to consider page 2, lines 9-17, of the specification as to further advantages including quicker and surer operation without the pocket movement. In stark contrast to the claim 1 “holding device,” the trap 13 of Kern, the only element of Kern that can possibly be reasonably interpreted to correspond to the claim 1 “holding device,” must pivot to be in different orientations for feeding and removing the envelope and is subject to all of the noted disadvantages avoided by the present invention set forth by independent claim 1.

Accordingly, and as emphasized at the above-noted interview, Kern cannot be reasonably said to teach all the limitations of independent claim 1. Thus, the rejection of independent claim 1, and claims 2, 3, 5, 6, 8-11, 13, 25, and 26, all of which ultimately depend from claim 1, under 35 U.S.C. § 102(b) as being allegedly anticipated by Kern is again respectfully noted to be improper and the withdrawal thereof is respectfully requested.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 4, 7, and 12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kern. As was noted at the above-noted interview, claims 4, 7, and 12 all depend from amended independent base claim 1 and that the rationales offered to reject these claims do not cure the above-noted deficiencies of Kern as to not teaching or suggesting all the subject matter recited by this amended independent base claim 1. Thus, the rejection of claims 4, 7, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Kern is also noted to be improper and the withdrawal thereof is respectfully requested.

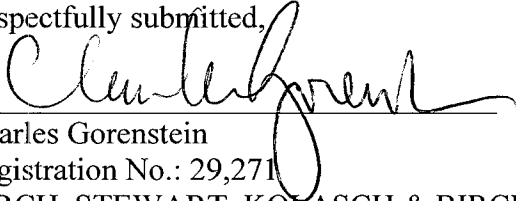
#### **CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Reg. No. 40,440 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: April 26, 2010

Respectfully submitted,

By 

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